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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,912

03/26/2004

Junichiro Hosokawa

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/809,912

Applicant(s)

HOSOKAWA ET AL.

Examiner

Hoa V. Le

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 10/301,762.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

This application is before the examiner for consideration on the merits.

I. The prior art submissions filed on 26 March 2004 (with USSN 10/297,633 in a distinct art. It could be an error) and 02 February 2005 have been considered to the extent of the English language being provided.

II. The prior art submission filed on 04 June 2004 is also considered to the extent to the English language translation of the Foreign Office Action only since it shows that the teachings and suggestions in the applied Japanese patents are relevant and applied to the claimed invention as submitted. Therefore, English language translations of pertinent portions or English language equivalents of the applied Japanese patents should have been timely provided for a proper consideration and examination.

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuoka et al (5,384,236).

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Matsuoka et al disclose and teach a method for using a compound being reasonably read within the general formula (C) as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. Please see the whole disclosure of the applied reference, especially at col.2:6 and 16-8:2, compounds (1) to (57), 56:39-42, Table B on cols.63 and 64, 65:50-60 and 68:9-11.

Matsuoka et al do not specify the properties with respect to "Hammett...value...to 1.0" as that in claim 21, "change a film...to 3.0" as that in claim 22, "pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in claim 24. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Matsuoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Matsuoka et al.

IV. Claims 21-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagaoka et al (5,460,929).

Nagaoka et al disclose and teach a method for using a compound being reasonably read within the general formula (C) as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. Please

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see the whole disclosure of the applied reference, especially at col.1:8-9, 9:14 to 14:67, compounds (1) to (48), "Emulsion D" on col.176:26 and on col.179 with respect to the top Table on left column of "Emulsion" from C then to D and on col.182 with Table 84 with "6<sup>th</sup>" layer.

Nagaoka et al do not specify the properties with respect to "change a film...to 3.0" as that in claim 22, "pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in claim 24. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Nagaoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Nagaoka et al.

V. Claims 21-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mihayashi et al (5,543,282).

Mihayashi et al disclose and teach a method for using a compound being reasonably read within the general formula (C) as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. Please see the whole disclosure of the applied reference, especially at col.1:13:6, 3:25 to 10:22, compounds (1) to (52), 38:51-52, col.68 with respect Emulsion 5 on Table 1 and Samples 116 and 117 on Table 3 at cols. 87 and 88, 89:34, Table 5 with "Emulsion" "7-1" and "8-1" on cols.

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95 and 96, Table 6 with "Sample" "303", "304", "307", "308", "311" and 312" on cols. 97 and 98.

Mihayashi et al do not specify the properties with respect to "change a film...to 3.0" as that in claim 22, "pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in claim 24. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Mihayashi et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Mihayashi et al.

VI. The above applied references are insufficient to applied against claim 26. However, the teachings and suggestions in the prior art submission filed on 04 June 2004 may be sufficient to applied against it as that on the record in the Foreign Office Action as submitted. Applicants have not early and timely provide English language translations of pertinent portions or English language equivalents of the applied Japanese patents should have been timely provided for a proper consideration and examination. For the record, claim 26 (1) is not rejected over the above references (2) may be provisionally rejected over the teachings and suggestions in the applied Japanese patents as that on the record in the Foreign Office Action. English language translations of pertinent portions or English language equivalents of the applied Japanese patents

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VII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over the teachings and suggestions of one or more of the Japanese Patents with respect to JP 2000-181002, JP 11-119364, JP 51-59943, JP 54-32552 and JP 2001-133931 for the reasons as stated in the Foreign Office Action as submitted. Accordingly, English language translations of pertinent portions or English language equivalents of the applied Japanese patents must be timely provided before a brief on appeal is filed. Otherwise, the appeal will not be considered and is dismissed.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

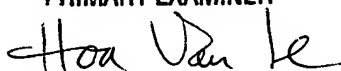
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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
15 April 2005

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.